

wherein the support comprises a resting surface extending in a direction opposite of the rotary mixer barrel and behind the wheels such that when the mixer is in the mixing position the mixer rests upon the resting surface and a foot extends beyond the wheels of the mixer such that when the mixer is in the pouring position the mixer rests upon the foot.

3. (Amended) The mixer of claim 2, wherein the engine is a rotary lawn mower engine.

5. (Amended) The mixer of claim 4, wherein the electric motor is a washing machine motor.

### REMARKS

#### A. Status of the Application

Claims 1-6 were originally submitted in the present application. In the Office Action dated May 9, 2002, the Examiner rejected: claims 3 and 5 under 35 U.S.C. § 112 as being indefinite; claims 1 and 4-6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,294,548 to Watson ("Watson"); claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over Watson in view of and U.S. Patent No. 5,492,401 to Halsted ("Halsted"). By this Response, claims 1, 3, and 5 have been amended; thus, Claims 1-6 are at issue.

#### B. Rejection Under 35 U.S.C. §112

Examiner has rejected claims 3 and 5 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. By this response, the claims have been amended to address the Examiner's rejections. In view of the amendments, Applicant respectfully requests Examiner to withdraw the rejection of claims 3 and 5 under 35 U.S.C. §112.

Serial No. 09/805,786  
Attorney Docket No. 3522 P 003  
Page 3

**C. Rejection Under 35 U.S.C. § 103**

**1. Rejection of Claims 1 and 4-6 Over Watson**

Claim 1 and 4-6 stand rejected by Examiner under 35 U.S.C. Section 103(a), as being obvious and unpatentable over Watson. Applicant respectfully traverses this rejection.

Claim 1 has been as amended to include the element, "a mounting plate abutting the motor and surrounding the motor output shaft." It is noted that the primary reference, Watson, does not disclose, teach or suggest this element of amended claim 1. Thus, the rejection of claims 1 and 4-6 under 35 U.S.C. §103(a) is inappropriate in view of the deficiency of the primary reference.

Further, there is nothing in the art to suggest curing this deficiency by modifying Watson to include this element. The law is clear that the cited reference must suggest the invention described by the claim, or the Examiner must present a convincing line of reasoning as to why one skilled in the art would have found the claimed invention obvious in light of the teachings of the cited reference in order to support a conclusion that a claim is directed to obvious subject matter. See *Ex Parte Clapp*, 227 U.S.P.Q. 972 (PTO Bd. App. 1985) (emphasis added). "[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski et al.*, 871 F.2d 115, 10 U.S.P.Q.2d 1397, 1398, (Fed. Cir. 1989), citing, *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Unless the reference suggests the particular combination, it cannot show the actual invention was obvious. *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-1375, 28 U.S.P.Q.2d 1801, 1817 (N.D. Ill. 1993).

Here, there is no motivation whatsoever, either in the cited reference or the prior art, to modify Watson to include a mounting plate abutting the motor and surrounding the motor output shaft. Indeed, Watson teaches away from such a modification. Specifically, Watson discloses a concrete mixer drive for a hand wheeled barrow type of mixer, wherein the drive comprises an electric motor *mounted on the main supporting bearing of the mixer bowl*. In view of this structural teaching, one would not be motivated to modify Watson to include a mounting plate that abuts the motor and surrounds the motor out put shaft. In fact, such a modification would be antithetical to the structure disclosed in Watson.

In view of the above, Applicant respectfully submits that the § 103 rejection of claim 1 has

Serial No. 09/805,786  
Attorney Docket No. 3522 P 003  
Page 4

been obviated, and respectfully requests removal of the same. Claims 4-6 ultimately depend from independent claim 1 and therefore, include all of the limitations of claim 1. Accordingly, for the same reasons claim 1 is patentable over Watson, claims 4-6 are also patentable over Watson. Applicant, therefore, submits that the § 103 rejection has also been obviated with respect to claims 4-6.

Rejection of Claims 2 and 3 Over Watson In View of Halsted

The Examiner has rejected claims 2 and 3 under 35 U.S.C. §103(a) as being unpatentable over Watson in view of Halsted. Applicant respectfully traverses this rejection.

Applicant respectfully submits that the combination of Watson and Halsted would not yield the barrel mixer recited in claims 2 and 3 of the present Application as neither Watson nor Halsted alone, or combined, disclose Applicant's claimed invention. Claims 2 and 3 of the present Application include the limitations of amended claim 1. Again, claim 1 includes the limitation of "a mounting plate abutting the motor and surrounding the motor output shaft." As discussed above, Watson does not teach this element of claim 1. Thus, the rejection of claims 2 and 3 under 35 U.S.C. §103(a) is inappropriate in view of the deficiency of the primary reference.

Moreover, Applicant submits that Watson and Halsted are not properly combinable under §103(a). Again, the law is clear that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by Examiner. "[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski et. al.*, 10 U.S.P.Q. 2d 1397, 1398, (Fed. Cir. 1989), citing, *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). That motivation cannot come from the Applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). As discussed above, Watson teaches away from the modification suggested by the Examiner.

Furthermore, the decomposition of an invention "into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *Id.* The Federal Circuit has held:

[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art

Serial No. 09/805,786  
Attorney Docket No. 3522 P 003  
Page 5

so that the claimed invention is rendered obvious . . . [o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

*In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). In other words, it is impermissible for the Examiner to pick and choose elements from Watson and Halsted to derive Applicant's invention. Examiner may not, therefore, select the motor of Watson and the mounting plate of Halsted and simply ignore the other structural limitations expressly taught by these references.

Because the Examiner has pointed to nothing in either Watson, Halsted or any of the other prior art, the modification suggested by the Examiner can only be a result of hindsight analysis. Such an analysis is insufficient to present a *prima facie* case of obviousness. Thus, Applicant submits that the § 103 rejections of Claims 2 and 3 have been obviated. Therefore, Applicant respectfully requests reconsideration and removal of the same.

#### CONCLUSION

In view of the above Amendments and Remarks, Applicant respectfully submits that claims 1-6 are clearly patentable over the cited prior art, and are in condition for allowance. Applicant respectfully requests that the Examiner withdraw the rejections of claims 1-6 and enter an allowance

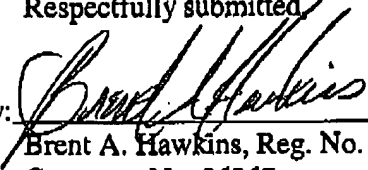
Serial No. 09/805,786  
Attorney Docket No. 8522 P 003  
Page 6

of the same. Applicant further invites the Examiner to contact the undersigned attorney to discuss any matters pertaining to the present Application.

Respectfully submitted

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this document is being facsimile transmitted to Examiner David L. Sorkin, Group Art Unit: 1723, at the U.S. Patent and Trademark Office on August 9, 2002 to Fax No. 703-872-9310.

  
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Serial No. 09/805,786  
Attorney Docket No. 3522 P 003

**MARKED UP COPY OF SPECIFICATION AMENDMENTS**

At page 3, paragraph 2, lines 4-7,

--The motor may be mounted in a first mounting plate or frame of the support with its shaft projecting through said plate or frame, and the barrel mounted on a second mounting plate or frame by means of a right-angle gear (a gear whose output and input shafts are at right [angels] angles) connected directly or indirectly to the motor shaft. The right-angle gear may comprise a worm gear.--

# **MARKED UP COPY OF CLAIM AMENDMENTS**

1. (Amended) A barrel mixer comprising:  
a rotary mixer barrel;  
a support for the rotary mixer barrel, the support comprising a tipping arrangement for the rotary mixer barrel, wherein the support limits tipping of the rotary mixer barrel between a mixing position in which the rotary mixer barrel is angled to retain its contents and a tipping position in which the rotary mixer barrel is angled so that its contents are poured out, the support further comprising wheels disposed proximate a bottom portion of the support;  
a motor having a motor output shaft aligned perpendicular to an axis of rotation of the rotary mixer barrel;  
a mounting plate abutting the motor and surrounding the motor output shaft;  
a transmission mounted on the support for rotating the rotary mixer barrel, the transmission including step-down gearing between the motor and the rotary mixer barrel, the motor and gearing tipping with the rotary mixer barrel when the support is moved between the mixing position and the pouring position, wherein the motor and transmission are disposed substantially behind the wheels such that the motor and transmission are disposed on the same side of the support; and,  
wherein the support comprises a resting surface extending in a direction opposite of the rotary mixer barrel and behind the wheels such that when the mixer is in the mixing position the mixer rests upon the resting surface and a foot extends beyond the wheels of the mixer such that when the mixer is in the pouring position the mixer rests upon the foot.

3. (Amended) The mixer of claim 2, wherein the engine is [of the type used to power rotary lawn mowers] a rotary lawn mower engine.

5. (Amended) The mixer of claim 4, wherein the electric motor is [of the type used to power washing machines] a washing machine motor.